

REMARKS

Reconsideration and withdrawal of the rejections of the claimed invention is respectfully requested in view of the amendments, remarks and enclosures herewith, which place the application in condition for allowance.

I. STATUS OF CLAIMS AND FORMAL MATTERS

Claims 33, 36-38 and 40-53 are still pending in this application. The element of claim 35 has been inserted into claim 33 and claim 35 has been cancelled. The reference to non-elastic areas is supported throughout the specification, e.g., page 3, line 4 through page 4, line 12. No new matter has been added by this amendment.

While the applicants disagree with the maintaining of the obviousness rejection of claims 33, 35-38 and 40-53, the applicants did agree with the first Office Action which appeared to understand that there was no basis for objecting to the specification and the drawings (except for the reference to claim 1 in the specification)

It is submitted that the claims, herewith and as originally presented, are patentably distinct over the prior art cited in the Office Action, and that these claims were in full compliance with the requirements of 35 U.S.C. § 112.

II. THE OBJECTION TO THE SPECIFICATION HAS BEEN OVERCOME

The nature of the objection to the term “carrier” is not well understood by the applicants as it appears that the Examiner recognizes that the claims are directed toward an unidirectionally elastic bandage which comprises a backing layer, an adhesive layer and a releasable protective layer.

One of ordinary skill in the bandage arts would understand that the releasable protective layer would cover the adhesive layer until the bandage is ready for use. As such, one of ordinary skill in the art would not read “underside of the carrier” as being the underside of the releasable protective layer, but of the backing layer.

As noted in *In re Suitco* (Fed. Cir. – April 14, 2010), “[t]he PTO’s construction here, though certainly broad, is unreasonably broad. The broadest-construction rubric coupled with the term “comprising” does not give the PTO an unfettered license to interpret claims to embrace anything remotely related to the claimed invention. Rather, claims should always be read in light of the specification and teachings in the underlying patent. See *Schreiber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 217 (1940).”

Although not directly on point because the decision was based on claim interpretation, the applicants note that while the entirety of the specification may be relied upon, the interpretation of the specification and the claims should be based upon a reasonable interpretation based on the specification and the state of the art, i.e. there would be no confusion about the applicants' description to anyone who has ever used a bandage.

With respect to the reference to "claim 1" in the specification, this paragraph has been amended to address this objection.

III. THE OBJECTION TO THE DRAWINGS HAVE BEEN ADDRESSED

The drawings were objected to under 37 CFR 1.83(a), but the remainder of the objection uses the wrong standard for making this objection, i.e. the Examiner then states "[t]he drawings **must** show every feature of the invention specified in the claims." (emphasis added) This is incorrect.

Form paragraph 6.22.01 (Drawings Objected To, Details Not Shown) states in part "[t]he drawings are objected to under 37 CFR 1.83(a) because they fail to show [1] as described in the specification. Any structural detail that is **essential for a proper understanding** of the disclosed invention **should be** shown in the drawing. MPEP § 608.02(d)." (emphasis added) *see also MPEP 608.02(e)*.

In the present case, the drawings provided by the applicants are not essential for a proper understanding of the disclosed invention (i.e. one could understand the nature and scope of the invention by reading the specification without the drawings; the drawing were merely provided for the illustrative purposes.). Moreover, the guidance provided in the MPEP is that the drawings feature are provided at the discretion of the applicants ("should be" -> optional to show; "shall be" -> must show). Therefore, this objection should be withdrawn.

IV. THE 35 U.S.C. 112, 1ST PARAGRAPH REJECTION HAS BEEN OVERCOME

Claim 33 was rejected as allegedly failing to comply with the written description requirement. The applicants refer to the explanation given in section II. above. In order to expedite prosecution, the applicants have amended claim 33 to refer to the backing layer.

V. THE 35 U.S.C. 103(a) REJECTION HAS BEEN OVERCOME

Claims 33, 35-38 and 40-53 were rejected as allegedly being obvious over Schäfer et al. (US 4,424,808 – "Schäfer") in view of Fabo (US 5,540,922 – "Fabo") and/or Lindqvist et al. (US 6,051,747 – "Lindqvist"). The applicants maintain their position from their 1 April 2010

response, which is reproduced below and offer the following additional comments in light of the claims as amended.

For the claims as amended the applicants note that the combination of Schäfer, Fabo and Lindqvist differs from the applicants' claims in that none of the references suggest areas of elasticity and non-elasticity in the bandage.

Furthermore, the interpretation that Schäfer somehow reads on or is related to the applicants' claimed bandage because the bandage of Schäfer can be torn into smaller elements is misplaced.

First, any modification of the reference teaching cannot render the respective teaching either inoperable or unsuitable for its intended use.¹ Second, the applicants' claimed bandage is unidirectionally elastic bandage and must be able to supporting joints. Nothing within the teaching of Schäfer alone or in combination with Fabo and Lindqvist suggests these elements of the invention or a means of modifying Schäfer without destroying its intended use.

For the claims as amended or as previously presented, the reliance on *Aller* in the revised rejection (which presumably was obtained from MPEP 2144.05, section II.A) is misplaced because the very next section, II.B. (Optimization of Ranges) states that "[a] particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. *In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).", i.e. not only is the rejection predicated on the unlikely "picking and choosing" success by the skilled artisan, but that the skilled artisan recognized elasticity and the feature of claim 45 as being results-effective; nothing within the teaching of Schäfer, Fabo and Lindqvist made the assertion the Examiner had made.

With regard to the generic reliance on *Ex parte Smith* (citing KSR) with regard to combination of elements, this overbroad application of *Smith* is precisely the reason for the "Examination Guidelines Update: Developments in the Obviousness Inquiry After KSR v. Teleflex", Federal Register, vol. 75, no. 169 (Wednesday, September 1, 2010 – Docket No. PTO-

¹ "If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959)."

P-2010-0055). As noted in the “Teaching Points”, an obvious to try rationale may be proper when the possible options for solving a problem were known and finite. *However, if the possible options were not either known or finite, then an obvious to try rationale cannot be used to support a conclusion of obviousness.*” (emphasis added) see also *Rolls-Royce, PLC v. United Technologies Corp.*, 603 F.3d 1325 (Fed. Cir. 2010). When considering the teachings of Schäfer, Fabo and Lindqvist as a whole as is required for making a determination of obviousness, the skilled artisan would be confronted with an infinite array of possibilities and would not reasonably arrive at the applicants invention without the applicants’ claims before them.

Applicants previous response filed on 1 April 2010 (Applicants note that comments with respect to Gantner are no longer applicable)

A. Combination of Schäfer, Fabo, Lindqvist and/or Gantner does render obvious amended claim 33 which now includes the element of previous claim 39

The rejection of Schäfer, Fabo, Lindqvist further in view of Gantner (for claims 41-51) did not include claim 39. While the Schäfer, Fabo and/or Lindqvist rejection did include claim 39 in the header, the explanation of the rejection did not include a discussion of how the element that “the adhesive is applied across the entire surface of or on a part of the underside of a carrier bandage or in the form of patterns” was described by the combination of Schäfer, Fabo and/or Lindqvist. Therefore, for this reason alone, claim 33 as amended is unobvious over Schäfer, Fabo, Lindqvist alone or further in view of Gantner.

The applicants contend that the previous arguments are still applicable and reserve the right to file a continuation application to continue prosecution on the scope of previous claim 33. However, the applicants would like to address a couple of points which were raised in the “Response to Arguments” section of the Office Action.

First, with regard to the elasticity of the bandage, the applicants note that this bandage is claimed as being used for supporting joints and the state of the art is such that it cannot be presumed that a previously known bandage would have the applicants claimed degree of elasticity.

As noted in the background section, having high elasticity to prevent folding of the bandage is accompanied by the bandage losing function for being able to support a joint (see paragraph [0004] of the publication of this application – U.S. Patent Appl. Pub. 2007-0179418).

Second, the Office Action appears to treat bandages for joint support (Schäfer) as being indistinguishable from bandages for wound dressing (Fabo and Linqvist)². However, there is no expectation of success for taking an isolated element from a bandage intended for wound dressing would be useful for a bandage intended for providing joint support and actually serves to teach away from the claimed invention in that one of ordinary skill in the art in the wound dressing arts would not want the level of support in a joint support bandage in order to avoid reinjuring the wound or any pain associated with removing a wound dressing bandage.

Therefore, the applicants' claimed unidirectionally elastic adhesive bandage is not obvious over the combination of Schäfer, Fabo, Lindqvist and/or Gantner for the claims as amended.

B. Consideration of the applicants' invention and the cited references as a whole for determination of obviousness extends to the dependent claims and is not limited to the independent claims

The only independent claim currently under examination is claim 33 and each of claims 35-38 and 40-53 which are either directly or indirectly dependent upon claim 33. As such, the applicants' dependent claims are unobvious for the reasons cited above in section A. However, the determination of obviousness also requires that the dependent claims be considered as a whole. By way of example, when tracking the claim dependencies, new claim 53 is actually a composite of the elements represented by claims 33, 40, 41, 42, 49, 50 and 53 (reproduced below):

33. (Currently amended) A unidirectionally elastic bandage, adhesive on one side and used for supporting joints, comprising a backing layer, an adhesive layer and a releasable protective layer

² Gantner appears to be relied for their reference to adhesives in general. Applicants note that should prosecution go to appeal, the Gantner reference could be disqualified as prior art if the applicant files a certified English language translation of their German priority document (DE 10 2004 012 442.6) as this has an earlier priority date (13 March 2004) than the earliest 102(e) date of the Gantner reference (8 April 2004).

characterized in that the bandage is embodied as a segment and has an elasticity of the backing layer in the range of 20% to 150% and that the adhesive layer has an adhesion force of 1.0-10.0 N,

characterized in that the bandage segment is transversely elastic or longitudinally elastic,
and

characterized in that the adhesive is applied across the entire surface of or on a part of the underside of a carrier bandage or in the form of patterns.

40. (Previously presented) The unidirectionally elastic adhesive bandage as claimed in claim 33, characterized in that the adhesive composed of self-adhesive polymers is selected from the group consisting of polyacrylates, silicones and polyisobutylenes.
41. (Currently amended) The unidirectionally elastic adhesive bandage as claimed in claim 40, characterized in that the elasticity of the backing layer lies in the range of between 44% and 56% ~~adhesive composed of self-adhesive polymers is selected from the group consisting of polyacrylates and polyisobutylenes.~~
42. (Previously presented) The unidirectionally elastic adhesive bandage as claimed in claim 41, characterized in that the backing layer is microbiologically nondegradable to an extent of more than 90%.
45. (Previously presented) The unidirectionally elastic adhesive bandage as claimed in claim 42, characterized in that of the backing layer is a woven fabric or a film or a combination of both made from viscose, polyester, polyamide, cotton or elastane.
49. (Previously presented) The unidirectionally elastic adhesive bandage as claimed in claim 45, characterized in that the backing layer has a warp number in the range of 300-350, and a weft number in the range of 100-140.

50. (Previously presented) The unidirectionally elastic adhesive bandage as claimed in claim 49, characterized in that the backing layer has a warp number in the range of 310-330 and a weft number in the range of 120-130.
53. (New) The unidirectionally elastic adhesive bandage as claimed in claim 50, characterized in that the bandage segment is rectangular with a side ratio of length to width of 1.2:1 to 1.8:1.

When determining the obviousness of a dependent claim such as claim 53, the issue is not whether the individual additional element is obvious, but whether the claimed invention as a whole is obvious, i.e. it would have been obvious for all of the elements represented by claims 33, 40, 41, 42, 49, 50 and 53 simultaneously present.

In this regard, the specific combination of elements represented by claim 53 is not taught or suggested or obvious as a whole when considering the combination of Schäfer, Fabo, Lindqvist with or without Gantner. While there is no limitation on the number of prior art references which can be used to establish a holding of obviousness, consideration of the prior art references as a whole means that the teachings beyond what is being relied upon in the rejection must also be considered.

It has long been held that *"[i]t is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art."* (see *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965)).

As such, the collective teachings of Schäfer, Fabo, Lindqvist with or without Gantner does not represent a finite number of predictable solutions to a problem especially not for the specific combination of references represented by claim 53. By way of analogy, it is not logical to assert that the winning Powerball lottery numbers would have been obvious because it was known that the numbers to be selected was known to be 1-50. Likewise, it would not have been obvious for the specific combination of elements represented by claim 53 to have been obvious

when considering all of the teachings (not just the sections relied upon) represented by Schäfer, Fabo, Lindqvist with or without Gantner.

(The applicants' arguments were directed toward claim 53 as being the best example of the position taken. However, these arguments also apply to the combination of elements represented by the other dependent claims, i.e. 35-38 and 40-52.)

CONCLUSION

In view of the remarks and amendments herewith, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are earnestly solicited. The undersigned looks forward to hearing favorably from the Examiner at an early date, and, the Examiner is invited to telephonically contact the undersigned to advance prosecution. The Commission is authorized to charge any fee occasioned by this paper, or credit any overpayment of such fees, to Deposit Account No. 50-0320.

Respectfully submitted,
FROMMER LAWRENCE & HAUG LLP

By: /Howard C. Lee/
Marilyn M. Brogan Howard C. Lee
Reg. No. 31,223 Reg. No. 48,104
Telephone: (212) 588-0800
Facsimile: (212) 588-0500